

REMARKS

Claims 23 and 40 are canceled without prejudice, claims 43 to 45 are added, and therefore claims 16 to 22, 24 to 39, and 41 to 45 are pending.

Applicants respectfully requests reconsideration of the present application in view of this response.

Applicants thank the Examiner for accepting the drawings.

With respect to paragraph eight (8) of the Office Action, Applicants thank the Examiner for indicating that claims 23 to 31, 40 and 42 contained allowable subject matter. Accordingly, the claims have been rewritten as follows:

Claim 16 has been rewritten to include the features of claims 17, 18 and 23, and claim 23 has been canceled without prejudice. Claim 24 now depends from claim 16 (and not canceled claim 23). Accordingly, claim 16 and its dependent claims 24 to 30 are allowable.

Claim 31 has been rewritten to include the features of original claim 16. Accordingly, claim 31 is allowable.

Also, as explained below, claim 19 has been rewritten to include the features of original claim 16, 17 and the further feature that the light transmitted by the projection unit to the display surface is deflected directly into the direction of a user, so that claim 19 is allowable. Claim 18 now depends from claim 19 and is therefore allowable for the same reasons, as are claims 20, 21 and 22 which depend from claim 18, and therefore from claim 19.

Claim 32 now depends from claim 18 (and not claim 16), which depends from allowable claim 19, and is therefore allowable for the same reasons as claim 19.

Claim 33 has been rewritten as a dependent claim as to its wherein clause and now depends from claim 16, and is therefore allowable for the same reasons as claim 16.

Claims 34 to 39 and 41 depend from claim 33, and are therefore allowable for the same reasons as claim 33, which depends from allowable claim 16.

Claim 40 is canceled without prejudice.

Claim 42 now depends from new claim 43, and is therefore allowable for the same reasons as new claim 43.

New claims 43 and 44 do not add any new matter and are supported by the present application, including the specification. Claim 43 includes the features of original claim 16, and the further feature in which the projection unit includes a laser-beam generating unit for

generating the real image with laser beams, which is not disclosed by the applied reference, as is further explained herein. Claim 44 depends from claim 43 and is therefore allowable for the same reasons.

Approval and entry are respectfully requested, as is withdrawal of the objections to claims 23 to 31, 40 and 42.

With respect to paragraph two (2) of the Office Action, claim 42 was objected to because it referred to a first surface portion as to the second image. Claim 42 has been corrected to refer to a second surface portion in this context. Approval and entry are respectfully requested, as is withdrawal of the objection.

With respect to paragraph four (4), claims 16 to 21, 32 to 38 and 41 were rejected under 35 U.S.C. § 102(b) as anticipated by Yazaki, GB 2 269 681.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, the claims have been rewritten as follows:

Claim 16 has been rewritten to include the features of claims 17, 18 and 23, and claim 23 has been canceled without prejudice. Claim 24 now depends from claim 16 (and not canceled claim 23). Accordingly, claim 16 and its dependent claims 24 to 30 are allowable.

Claim 31 has been rewritten to include the features of original claim 16. Accordingly, claim 31 is allowable.

Also, as explained below, claim 19 has been rewritten to include the features of original claim 16, 17 and the further feature that the light transmitted by the projection unit to the display surface is deflected directly into the direction of a user, so that claim 19 is allowable. Claim 18 now depends from claim 19 and is therefore allowable for the same reasons, as are claims 20, 21 and 22 which depend from claim 18, and therefore from claim 19.

In particular as to claim 19, as presented, the deflection of the light into the direction of a user is disclosed at page 5, lines 33 through 34, of the Substitute Specification. As shown in Figures 1 and 2, the light is directly reflected by the display surface to the user. In contrast, the subject matter of "Yazaki" concerns a head-up display for vehicles, where an image is projected onto a reflecting surface at the instrument panel of the vehicle in accordance with the embodiments and Figures 3 and 5, and is only reflected from there into the direction of the windshield. This reflection occurs based on the objective that an observer can perceive a virtual image via the reflection at the windshield. So that an observer is not disturbed by the real image, and since the "Yazaki" reference does not relate to the perception of the real image by the driver, this reference refers to a way to prevent the light from being deflected directly by the reflection surface into the direction of an observer. (See, e.g., page 10, third paragraph of the Yazaki reference). Therefore, the reference teaches away from designing the reflection surface so that the light transmitted by the projection unit to the reflection surface is deflected directly in the direction of an observer. In particular, the "Yazaki" reference uses a prevention structure to prevent light from propagating directly in the direction of an observer. Against this background, the "Yazaki" reference does not disclose or suggest the subject matter of claim 19, as presented. Accordingly, claim 19 is allowable.

Claim 32 now depends from claim 18 (and not claim 16), which depends from allowable claim 19, and is therefore allowable for the same reasons as claim 19.

Claim 33 has been rewritten as a dependent claim as to its wherein clause and now depends from claim 16, and is therefore allowable for the same reasons as claim 16.

Claims 34 to 39 and 41 depend from claim 33, and are therefore allowable for the same reasons as claim 33, which depends from allowable claim 16.

Claim 40 is canceled without prejudice.

Claim 42 now depends from new claim 43, and is therefore allowable for the same reasons as new claim 43.

New claims 43 and 44 do not add any new matter and are supported by the present application, including the specification (page 3, fourth paragraph of the Substitute Specification). Claim 43 includes the features of original claim 16, and the further feature in which the projection unit includes a laser-beam generating unit for generating the real image with laser beams, which is not disclosed by the applied reference, which is not identically disclosed (or even suggested) by the "Yazaki" reference. In particular, the "Yazaki" reference only refers to a projection unit using a backlighted liquid-crystal display, and therefore does not identically disclose (or even suggest) the use of laser projection is given. Claim 44 depends from claim 43 and is therefore allowable for the same reasons as claim 43.

Claims 17 and 42 also now depend from new claim 43, and are therefore allowable for the same reasons as new claim 43.

With respect to paragraph seven (7), claims 22 and 39 were rejected under 35 U.S.C. § 103(a) as obvious over the "Yazaki" reference as applied to claims 18 and 35.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

U.S. Pat. App. Ser. No. 10/088,727
Attorney Docket No. 10191/2289
Reply to Office Action of 11/20/06

Also, as explained herein, claim 19 has been rewritten to include the features of original claim 16, 17 and the further feature that the light transmitted by the projection unit to the display surface is deflected directly into the direction of a user, so that claim 19 is allowable. Claim 18 now depends from claim 19 and is therefore allowable for the same reasons, as are claims 20, 21 and 22 which depend from claim 18, and therefore from claim 19.

Claim 39 depends from claim 33, and is therefore allowable for the same reasons as claim 33, which depends from allowable claim 16, as explained herein.

Accordingly, claims 16 to 22, 24 to 39, and 41 to 45 are allowable.

CONCLUSION

In view of the above, it is believed that the objections and the rejections have been obviated, and it is therefore respectfully submitted that claims 16 to 22, 24 to 39, and 41 to 45 are allowable. It is therefore respectfully requested that the objections and rejections be reconsidered and withdrawn, and that the present application issue as early as possible.

Respectfully submitted,

Dated: 1/30/2007

By: Gerard A. Messina

Gerard A. Messina
(Reg. No. 35,952)

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

Handwritten:
33, 865
Aurora C. DESITCH